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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

LFP IP, LLC,

Plaintiff,

vs.

LEE KEITH BRETT,

Defendant.

Case No.: 2:16-cv-00166-FMO-RAO

The Hon. Fernando M. Olguin

**MEMORANDUM OF
CONTENTIONS OF FACT AND
LAW SUBMITTED BY
PLAINTIFF LFP IP, LLC**

Final Status Conference: June 22,
2018

First Day of Trial: July 10, 2018

Plaintiff LFP IP, LLC (“Plaintiff”) respectfully submits the following
Memorandum of Contentions of Fact and Law pursuant to Local Rule 16-4:

1. CLAIMS AND DEFENSES – LR 16-4.1

16-4.1(a): Claims Plaintiff Has Pleaded and Plan to Pursue

Claim 1: Defendant infringed Plaintiff’s Registered Trademark(s) by promoting, advertising, preparing to distribute and/or selling “American Hustler” branded clothing items (15 U.S.C. § 1114(a)).

Claim 2: Defendant engaged in False Designation of Origin under the Lanham Act by falsely implying that Plaintiff endorsed, sponsored or authorized the “American Hustler” clothing items created, promoted and sold by Defendant (15 U.S.C. § 1125(a)).

16-4.1(b): Elements Required to Establish Plaintiff’s Claims

Claim 1: Infringement of Plaintiff’s Registered Trademark

A trademark is any word, name, symbol, device, or any combination thereof, used by a person to identify and distinguish that person’s goods from those of others and to indicate the source of the goods.

1 In this case, the Plaintiff contends that the Defendant has infringed the
 2 Plaintiff's trademark(s). The Plaintiff has the burden of proving by a
 3 preponderance of the evidence that:
 4

5 (1) HUSTLER® and/or HUSTLER HOLLYWOOD® are valid,
 6 protectable trademarks;
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8 (2) The Plaintiff owns the HUSTLER® and/or HUSTLER
 9 HOLLYWOOD® trademarks; and
 10

11 (3) The Defendant used the "American Hustler" mark on his goods,
 12 without the consent of the Plaintiff, in a manner that is likely to cause confusion
 13 among ordinary purchasers as to the source of the goods.
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15 AUTHORITY: *Ninth Circuit Manual of Model Jury Instructions*,
 16 §15.1[modified] and §15.5 [modified].
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20 **Claim 2: Federal Unfair Competition / False Designation of Origin**

21 The Plaintiff has the burden of proving by a preponderance of the evidence
 22 that:
 23

24 (a) The HUSTLER® and/or HUSTLER HOLLYWOOD® trademarks
 25 are valid, protectable marks;
 26

27 (b) Plaintiff owns the claimed trademarks;
 28

1 (c) Defendant used a mark, without the consent of Plaintiff, in a manner
2 that is likely to cause confusion among ordinary consumers as to the source,
3 sponsorship, affiliation or approval of the goods.
4

5 AUTHORITY: 15 U.S.C. §1125 (a)
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10 **16-4.1(c): A Brief Description of The Key Evidence In Support of**
11 **Plaintiff's Claims**

12 1. Plaintiff's Federal Trademark and Service Mark Registrations
13 (Plaintiff owns various HUSTLER® trademark registrations for various goods
14 and services, including but not limited to an incontestable registration for apparel
15 items, including shirts. Plaintiff also owns the HUSTLER HOLLYWOOD®
16 service mark for a chain of retail stores that feature various items for sale,
17 including but not limited to HUSTLER® branded t-shirts and HUSTLER®
18 branded merchandise).
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22 2. Examples of Plaintiff LFP's T-Shirts (various designs that Plaintiff
23 has sold over the years, some that feature American themes and the slogan
24 "Hardcore Since '74").
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3. Defendant's T-Shirt Designs (among other things, Defendant's t-shirt designs that feature "Hustler" prominently, and designs that feature the year 1974).

4. Defendant's website that features various "American Hustler" t-shirt designs.

16-4.1(h): Identification of Any Evidentiary Issues

Plaintiff perceives the following evidentiary issues at this time:

Defendant Brett's counsel just appeared in this action, on June 6, 2018. Previously Defendant Brett represented himself, in *pro per*. Accordingly, because counsel has not had any opportunity to discuss the evidence and exhibits, it is unknown what evidentiary issues might be in dispute at this time.

16-4.1(i): Issues of Law Germane to the Case

Under 15 U.S.C. § 1115(b), Plaintiff's incontestable registrations provide conclusive evidence of ownership, validity, and the exclusive right to use of the HUSTLER® mark.

1 **A. The Strength of the HUSTLER® Mark Favors Plaintiff.** The
 2 scope of trademark protection depends upon the strength of the mark, with
 3 stronger marks receiving greater protection than weaker marks. *See Miss World*
 4 *(UK) Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1448 (9th Cir.1988).
 5 Here, the incontestable HUSTLER® mark, used in connection with clothing, is
 6 deemed to be a strong mark because it is arbitrary or fanciful.
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10 **B. The Marks are Identical, Save for the Addition of a Descriptive**
 11 **Term¹.** The greater the similarity between the two marks at issue, the greater the
 12 likelihood of confusion. Similarities in terms of appearance, sound, and meaning
 13 should be considered, *see, e.g., Dreamwerks*, 142 F.3d at 1131; and similarities
 14 should be weighed more heavily than differences, *see Official Airline Guides,*
 15 *Inc. v. Goss*, 6 F.3d 1385 at 1392 (1993).
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24 ¹ “A ‘geographically descriptive term’ is any noun or adjective that designates
 25 geographical location and would tend to be regarded by buyers as descriptive of
 26 the geographic location of origin of the goods or services.” *McCarthy on*
 27 *Trademarks and Unfair Competition* § 14:2 (4th ed.)
 28

1 **C. The Products are Identical.** “In light of the virtual identity of
 2 marks, if they were used with identical products or services likelihood of
 3 confusion would follow as a matter of course.” *Brookfield Commc'ns, Inc. v. W.*
 4 *Coast Entm't Corp.*, 174 F.3d 1036, 1056 (9th Cir. 1999) [citations omitted]. The
 5 products at issue here, t-shirts, are identical and the marks are identical save for
 6 the addition of “American” (a term that was disclaimed by Brett before the
 7 USPTO)².
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13 **D. Brett’s Intent in Selecting the Mark and Creating Infringing**
 14 **Goods.** Where an alleged infringer chooses a mark he knows to be similar to
 15 another, one can infer an intent to confuse. *Entrepreneur Media, Inc. v. Smith*,
 16 279 F.3d 1135, 1148 (9th Cir. 2002). Here, Defendant also used various other
 17 indicia in his t-shirt designs that demonstrate an intent to confuse. For example,
 18 using the year “1974”; featuring HUSTLER prominently on his t-shirts; and
 19 using terms such as “original.”
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26 ² A disclaimer is a statement indicating that the applicant does not claim exclusive
 27 rights to the unregistrable portion of the mark. Here, Defendant disclaimed the
 28 word “American” as it was an unregistrable component of the purported
 “American Hustler” mark.

1 **E. Overlap of Marketing Channels.** Further, in addition to the
 2 relatedness of the products, both parties use the Internet for marketing,
 3 advertising and selling the t-shirts, “a factor that courts have consistently
 4 recognized as exacerbating the likelihood of confusion.” *Brookfield* at 1057. In
 5 the case of a defendant’s marketing its subject goods on the Internet, the three
 6 most important *Sleekcraft* factors in evaluating the likelihood of confusion are:
 7 (1) the similarity of the marks; (2) the relatedness of the goods and services; and
 8 (3) the parties’ simultaneous use of the web as a marketing channel.
 9 *Perfumebay.com, Inc. v. eBay, Inc.*, 506 F.3d 1165, 1173 (9th Cir. 2007); *see also*
 10 *Internet Specialties West, Inc. v. Milon-DiGriorgio Enterprises, Inc.* 559 F.3d
 11 985, 990 (9th Cir. 2009). Here, Plaintiff contends that: (i) the marks are
 12 confusingly similar and/or Defendant used the distinctive HUSTLER® mark; (ii)
 13 the goods are identical; and (iii) both parties used the Internet as a marketing
 14 channel to both promote and sell their t-shirts.
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21 **2. BIFURCATION OF ISSUES – LR 16-4.3**

22 None.

23 **3. JURY TRIAL – LR 16-4.4**

24 Plaintiff requests a jury.

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3 **4. ATTORNEYS' FEES – LR 16-4.5**

4 Plaintiff seeks to recover its costs and attorneys' fees under 15 U.S.C.
5 §1117.
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8 **5. ABANDONMENT OF ISSUES – LR 16-4.6**

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10 Plaintiff will not be proceeding with the claim of Federal trademark
11 dilution. Plaintiff previously agreed to dismiss this claim on January 4, 2017, but
12 Defendant would not sign a stipulation for dismissal. In addition, Plaintiff will
13 not be proceeding with its claim under the Anticybersquatting Consumer
14 Protection Act (ACPA).
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18 Dated: June 8, 2018

19 MARK S. HOFFMAN, A
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21 LIPSITZ GREEN SCIME CAMBRIA LLP

22 By: /s/ Jonathan W. Brown
23 Jonathan W. Brown, Esq.
24 Attorneys for Plaintiff LFP IP, LLC
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